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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,519	06/11/1999	MICHAEL D. ELLIS	UV-52	9514

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EXAMINER

TRAN, HAI V

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/330,519

Applicant(s)

ELLIS ET AL.

Examiner

Hai Tran

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/04/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-125 is/are pending in the application.
- 4a) Of the above claim(s) 1-50,57,59,82,84,107 and 109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-56,58,60-81,83,85-106,108 and 110-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Reopened Prosecution***

In view of the Pre-Appeal brief filed on 05/17/2006, PROSECUTION IS HEREBY REOPENED. A new Office Action is set forth below.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



**KELLEY CHRISTOPHER S.**

### ***Response to Arguments***

Applicant's arguments filed 05/17/2006 have been fully considered but they are not persuasive.

Applicant argues (see Pre-Appeal Brief, page 5) , "... (Matthews, col. 10, lines 6-10). Applicants respectfully submit that this disclosure of Matthews still does not make up for the deficiencies of the Examiner's rejection described above. The use of "predictive viewing tendencies" suggests an approach for predicting which shows the user is likely to watch based on the user's ~ viewing history. In contrast, applicants' independent claims 51, 76, and 101 define the monitoring of a user's current actions to determine a potential upcoming need for supplemental information, and the supplying of that supplemental information in response to the current actions that are indicative of the potential upcoming need."

In response, the Examiner respectfully disagrees with Applicant because Applicant clearly misconstrues Matthews' s section (Col. 10, lines 6-13). The Examiner

cites "For instance, the system might pre-cache supplemental information about certain shows before they air based on predictive viewing tendencies, or as part of a promotional data broadcast advertising the show. This permits local interactive functionality between the viewer and the viewer computing unit, in addition to full network interactive functionality between the viewer and the program provider." It is clear that Matthews 's section does not suggest anything about the use of "predictive viewing tendencies" as an approach for predicting which shows the user is likely to watch based on the user's ~ viewing history, as alleged by Applicant, but rather based on current user interaction with the interactive system.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 101-106, 108, and 110-125 defines a machine – readable media- embodying functional descriptive material; However, the claim does not define a computer-readable medium or memory and is thus directed to non-statutory subject matter for that reason.

Moreover, the specification page 3, lines 25-page 4, lines 11 and many other locations within Applicant 's specification clearly suggests that the –readable media- (page 4, lines 3-22; page 10, lines 1-11; page 12, lines 15-25; page 17, lines 15-32;

etc... indicates –media- is a other forms of propagated signals (e.g., carrier waves, signal, etc...). A “signal” embodying functional descriptive material is neither a process (action) , machine, manufacture nor composition of matter (i.e., tangible “thing”) and therefore does not fall within one of the four statutory categories of § 101. Rather, Signal” is a form of energy, in the absence of any physical structure or tangible format.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

The Examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, broadcast waves, etc... defined in the specification. Any amendment to the claim should be commensurate with its corresponding disclosure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2623

1. Claims 51, 52, 54-56, 58, 65-66, 68, 71-77, 79-81, 83, 90-91, 93, 96-102, 104-106, 108, 115-116, 118, 121-125 are rejected under 35 U.S.C. 102(e) as being unpatentable by Matthews, III et al. (US 6025837).

Claim 51, Matthews discloses an interactive television program guide system in which an interactive program guide is implemented on a user TV equipment of a plurality of users (Cached; Fig. 4, el. 104; Col. 8, lines 52-65+), comprising:

Local memory 96 that is configured to store program guide data for use by the interactive TV program guide (Col. 8, lines 52-65+); and

Remote memory (Fig. 1, el. 54) at a remote location 22 that is configured to store supplemental data for access by the interactive TV program guide (Fig. 2),

wherein the interactive television program guide (EPG) monitors a user's current actions in navigating through the guide to determine a potential upcoming need for a given portion of the supplemental data, and wherein, responsive to current actions that indicate the potential upcoming need, the system automatically supplies the given portion of the supplemental data from the remote memory to the interactive TV program guide in advance of the upcoming need (Col. 10, lines 10-13; the system uses "predictive viewing tendencies" suggests an approach for predicting which shows the user is likely to watch based on the user's local interaction/navigation through the EPG the system between the user and the user's computing unit thereby automatically supplies/displays, Col. 9, lines 52-55, the given portion of the supplemental data 128 associated with the content of the landed cell through EPG's navigation from the remote memory to the interactive TV guide).

Claim 52, Matthews further discloses a TV distribution facility (Fig. 1 and 3) configured to distribute TV programming to the users' equipment (Abstract; Col. 5, lines 40-65+).

Claims 54-56 and 79-81, Matthews further discloses

The supplemental data includes detailed program descriptions for at least some of the program listings (Col. 7, lines 9-20)

Program schedule listing stored in the local memory can be accessed more rapidly with IPG than the supplemental data stored in the remote memory (Col. 8, lines 52-65+);

Access supplemental data stored at the headend requires a second memory lookup (Col. 10, lines 15-30).

Claim 58, Matthews further discloses the current user's actions involve viewing certain program listings (Matthews Col. 10, lines 6-65+).

Claims 65-66, Matthews further discloses wherein the supplemental data includes an Internet address; the IPG displays the Internet address as a link (Col. 10, lines 14-20);

Claim 68, Matthews (Col. 10, lines 5-65+) further discloses wherein the supplemental data is requested on-demand by the user 's current actions;

Claims 71-75, Matthews further discloses wherein the supplemental data includes video clips, audio clips, still images, bitmaps (col. 5, line, 18 and 51); Trivia (Col. 53-58; Col. 11, lines 39-44); Advertisements (Col. 5, line 21).

Claim 76, the method is analyzed with respect to system claim 51.

Claim 77, the method is analyzed with respect to system claim 52.

Claim 83, the method is analyzed with respect to system claim 58.

Claims 90-91, the method are analyzed with respect to system Claims 65-66 respectively.

Claim 93, the method is analyzed with respect to system Claim 68.

Claims 96-100, the method are analyzed with respect to system Claims 71-75 respectively.

Claims 101-102, apparatus claims are analyzed with respect to method claims 51-52.

Claims 104-106, apparatus claims are analyzed with respect to method claims 54-56.

Claim 108, apparatus claim are analyzed with respect to method claim 58.

Claims 115-116, apparatus claim are analyzed with respect to method Claims 65-66.



Claim 118, apparatus claim is analyzed with respect to method Claim 68.

Claims 121-125, apparatus claim are analyzed with respect to method Claims 71-75.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 60-64, 67, 69, 70, 85-89, 92, and 94, 95, 110-114, 117, 119, 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al. (US 6025837) in view of Shoff et al. (US 6240555).

Claims 60-62, Matthews further discloses wherein the supplemental data includes an application (Col. 7, lines 15-21); wherein the application is user selectable option (Col. 10, lines 14-20; see Fig. 5, el. 140);

Matthews does not clearly disclose "wherein the application is launched automatically by the program guide".

Shoff discloses the application is launched automatically by the program guide (Col. 10, lines 18-58) for interactive purpose. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matthews with Shoff so to provide to users with surprising trivia game which

quizzes the users as to possible outcomes of various scenes, and specifically, to entice users to participate along with the current program viewing in which users will experience an enjoyable way to view a TV program (Col. 10, lines 53-55).

Claims 63-64, 67, and 69, Shoff further discloses the supplemental data includes real-time information; the real-time information is overlaid on the TV program by the program guide on an on-going basis; wherein the supplemental data is displayed automatically by the program guide as soon as it is available (Col. 10, lines 53-58 and Col. 11, lines 59-65; Online Trivia game is real-time and is displayed as it is available).

Claim 70, Shoff further discloses wherein the supplemental data includes biographies. (Col. 11, line 30);

Claims 85-87, the method are analyzed with respect to system Claims 60-62 respectively.

Claims 88-89, 92, and 94, the method are analyzed with respect to system Claims 63-64, 67, and 69 respectively.

Claim 95, the method are analyzed with respect to system Claim 70.

Claims 110-112, apparatus claim are analyzed with respect to method Claims 60-62.

Claims 113-114, 117, 119 apparatus claim are analyzed with respect to method Claims 63-64, 67, 69.

Claim 120, apparatus claim are analyzed with respect to method Claim 70.

3. Claims 53, 78 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable Matthews, III et al. (US 6025837) in view of Davis (US 5559548).

Claim 53, Matthews discloses an apparatus and method of interactive program guide (IPG) as claimed, wherein the headend is configured to distribute TV programming to plurality of users as described in Abstract and Col. 5, lines 40-65+;

Remote memory is located at the headend (Fig. 1, el 44; Col. 7, lines 9-21, Col. 8, lines 5-20);

Matthews does not clearly disclose a main facility configured to provide program guide data to the headend for re-distribution to local memory. However, Matthews discloses a main facility configured to provide the supplemental data to the remote memory (Col. 9, lines 49-Col. 10, lines 13)

Davis discloses a main facility configured to provide program guide data to the headend for re-distribution to local memory (Col. 9, lines 39-49 and Col. 18-23). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matthews to include a main facility, as taught by Davis, so to enable distribution of program guides, advertisements and promotions from a central location to plurality remote locations while allowing insertion of schedule listings and additional information, i.e. commercials that are targeted to specific locales at the headend.

Claim 78, method claim is analyzed with respect to system claim 53

Claim 103, apparatus claim is analyzed with respect to system claim 53.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht  
10/13/2006

  
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PRIMARY EXAMINER